$R^{3'}$ and $R^{4'}$ form an unsubstituted heteroalicyclic ring provided that the heteroalicyclic ring is not piperidin-1-yl or morpholin-4-yl; or

a pharmaceutically acceptable salt thereof.

Remarks

Claims 1, 6 – 8, 10 – 13, 20 and 22 are pending. Claim 1 has been amended to remove non-elected subject matter.

I. Elections/Restrictions

On pages 2 and 3 of the Office Action, the Examiner has objected to claims 1 – 3, 6 – 8, 10 – 13, 20 and 22 as containing non-elected subject matter. The Examiner contends that restriction is proper.

In their response dated May 6, 2002, Applicants noted that the Examiner cited no art against the claims, emphasizing the Examiner's resultant obligation, in MPEP § 803.02, to extend her search of the claims. Applicants maintain, as they have throughout the prosecution of this application, that the Examiner's failure to find the claims unpatentable over any prior art following Applicants' election of a species obligates the Examiner to extend her search of the claims. "[S]hould no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim *will be* extended." *See* MPEP § 803.02 (emphasis supplied). Additionally, the MPEP explicitly contemplates that such a claim "can include independent and distinct inventions." *Id.* Only in the event that that the Markush-type claim is not found allowable will a provisional election of species be given effect. *Id.*

Applicants assert that the Examiner's grounds for maintaining the purported restriction requirement are wholly irrelevant to an examination following an election of species. Neither the USPTO nor its reviewing courts have relied upon patentable distinction in this context as reasons why an examiner should not, or cannot extend a search of claims against which no prior art is cited. Thus, Applicants courteously submit that the Examiner has departed from proper patent examining procedure by encumbering Applicants with the obligation of "restricting" the claims to subject matter of a scope less than which to they are entitled.

While not acquiescing to the Examiner's position that the Restriction Requirement is proper for the reasons she cites, and strictly in an effort to expedite the prosecution of the instant Application, Applicants have amended claim 1, thereby complying with the Restriction Requirement, in part.

The Examiner has asserted in paper 8 that searching groups I, II, and III together would be burdensome. Applicants assert, however, that it would not be burdensome to search group I, where all of the terms of the generic concept set forth in the present Office Action are met, save for the requirement that $R^{3'}$ and $R^{4'}$ can only form an unsubstituted pyrrolidin-1-yl ring. Applicants therefore respectfully urge that the Examiner expand the generic concept, at the very least, to encompass compounds where $R^{3'}$ and $R^{4'}$ form an unsubstituted heteroalicyclic ring, as presently recited in claim 1. Withdrawal and reconsideration of the objection is respectfully requested.

II. Objections to the Specification

Applicants acknowledge that the previous objections to the specification, set forth in the previous Office Action, have been overcome by the amendments filed 21 August 2002.

III. The Provisional Statutory-type Double Patenting Rejection

Applicants acknowledge the Statutory Double Patenting Rejection was overcome by the remarks made in the amendment filed 21 August 2002.

IV. The Provisional Rejection Under the Judicially Created Doctrine of Obviousness-Type Double Patenting

On page 3 of the Office Action, the Examiner has provisionally rejected claims 1 – 8, 10 – 13, 20 and 22 under the judicially created doctrine of obviousness-type double patenting over claims 1 – 4, 6 and 8 of U.S. Application Serial No. 09/863,905, now U.S. Patent No. 6,451,838 and claims 1 – 4, 6 and 8 of co-pending Application Serial No. 10/243,663.

In light of the Terminal Disclaimer filed herewith, Applicants assert that the provisional rejection under the judicially created doctrine of obviousness-type double

patenting has been overcome. Withdrawal and reconsideration of the rejection is respectfully requested.

V. Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn.

Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

Date April 7, 2003

By Reg. No. 35,792

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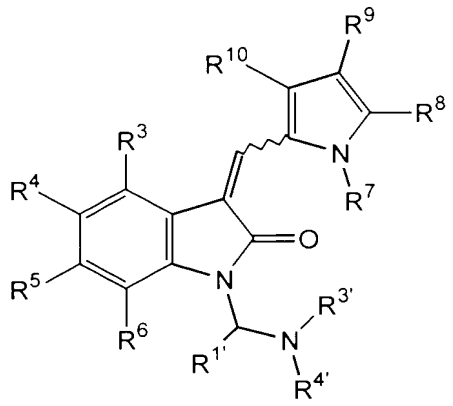
Version with Markings to Show Changes Made

In the claims:

1. (Amended) A compound of the Formula (I):



(I)

wherein:

R^3, R^4, R^5 and R^6 are independently selected from the group consisting of hydrogen, alkyl, trihaloalkyl, cycloalkyl, alkenyl, alkynyl, aryl, heteroaryl, heteroalicyclic, hydroxy, alkoxy, aryloxy, mercapto, alkylthio, arylthio, sulfinyl, sulfonyl, S-sulfonamido, N-sulfonamido, trihalomethane-sulfonamido, carbonyl, C-carboxy, O-carboxy, C-amido, N-amido, cyano, nitro, halo, O-carbamyl, N-carbamyl, O-thiocarbamyl, N-thiocarbamyl, amino and $-NR^{11}R^{12}$ where R^{11} and R^{12} are independently selected from the group consisting of hydrogen, alkyl, cycloalkyl, aryl, carbonyl, acetyl, sulfonyl, and trifluoromethanesulfonyl, or R^{11} and R^{12}, together with the nitrogen atom to which they are attached, combine to form a five- or six-member heteroalicyclic ring provided that at least two of R^3, R^4, R^5 and R^6 are hydrogen; or

R^3 and R^4, R^4 and R^5, or R^5 and R^6 may combine to form a six-membered aryl ring, a methylenedioxy group or an ethylenedioxy group;

R^7 is selected from the group consisting of hydrogen, alkyl, cycloalkyl, alkenyl, alkynyl, aryl, heteroaryl, heteroalicyclic, hydroxy, alkoxy, aryloxy, carbonyl, acetyl, C-amido, C-thioamido, amidino, C-carboxy, O-carboxy, sulfonyl and trihalomethane-sulfonyl;

R^8, R^9 and R^{10} are independently selected from the group consisting of hydrogen, alkyl, trihaloalkyl, cycloalkyl, alkenyl, alkynyl, aryl, heteroaryl, heteroalicyclic, hydroxy,

alkoxy, aryloxy, mercapto, alkylthio, arylthio, sulfinyl, sulfonyl, S-sulfonamido, N-sulfonamido, carbonyl, C-carboxy, O-carboxy, cyano, nitro, halo, O-carbamyl, N-carbamyl, O-thiocarbamyl, N-thiocarbamyl, C-amido, N-amido, amino and $-NR^{11}R^{12}$, wherein R^{11} and R^{12} are as defined above;

$R^{1'}$ is hydrogen or alkyl; and

$R^{3'}$ and $R^{4'}$ ~~are independently alkyl or combine to~~ form an unsubstituted heteroalicyclic ring ~~or a heteroaryl ring~~ provided that the heteroalicyclic ring is not piperidin-1-yl or morpholin-4-yl; or

a pharmaceutically acceptable salt thereof.